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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,845	05/17/2006	Walter Rosenbaum	2004P19118WOUS	5727

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EXAMINER

CHEN, GEORGE YUNG CHIEH

ART UNIT	PAPER NUMBER
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4115

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08/27/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/579,845	Applicant(s) ROSENBAUM, WALTER	
	Examiner George Chen	Art Unit 4115	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 May 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/17/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This communication is a non-final action in response to preliminary amendment filed on 05/17/2006. Claims 1-12 are pending.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 05/17/2006 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 34, 32, 30, 36, 38, each element in Fig. 4, 5, and 6. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any

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required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6 are rejected under 35 U.S.C. 101 as being non-statutory subject matter.

Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). If neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Claim 1 recites a method for forwarding post; in the event that the current post destination is NOT expired, the method comprises determining if a current post destination address is expired. This method is neither tied to another statutory class nor transform underlying subject matter to a different state or thing; thus rendering the claimed invention non-statutory subject matter.

Claims 2-6 are dependent from claim 1 and are therefore rejected for similar reasons as set forth above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Allen et al. (hereinafter Allen, US 5703783).

As per claim 1, Allen discloses a method of forwarding post, comprising the steps of:

- ✓ determining if a current post destination address is expired (column 2, line 24-40, the apparatus functions to identify incorrectly addressed mailpieces),
- ✓ if said destination address is expired, determining if an addressee of said post maintains a forwarding service (column 2, line 24-40, The read name and address are then compared to a list of names and former addresses of persons who have filed forwarding address information), and
- ✓ if said forwarding service is maintained, forwarding said post to an addressee destination address (column 2, line 24-40, If a forwarding address for the addressee is then retrieved along with a corresponding destination bar code and applied to the mail piece in place of the incorrect address).

As per claim 7, Allen discloses an apparatus for forwarding post, comprising:

- ✓ means **for** determining if a current post destination address is expired (column 2, line 24-40, the apparatus functions to identify incorrectly addressed mailpieces),

- ✓ means **for** determining if an addressee of said post maintains a forwarding service if said destination address is expired (column 2, line 24-40, The read name and address are then compared to a list of names and former addresses of persons who have filed forwarding address information), and
- ✓ means **for** forwarding said post to an addressee destination address if said forwarding service is maintained (column 2, line 24-40, If a forwarding address for the addressee is then retrieved along with a corresponding destination bar code and applied to the mail piece in place of the incorrect address).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-6 and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen in view of Kuebert et al. (hereinafter Kuebert, US 20020165729 A1).

As per claim 2, Allen discloses the method according to claim 1, but does not explicitly disclose further comprising the step of offering a forwarding service to said addressee if said addressee does not maintain a forwarding service. Kuebert teaches offering forwarding service to addressee if needed (Kuebert, 0039, if the recipient wishes the parcel delivers to Chicago instead; notification allows the recipient to redirect the parcel).

Therefore, it would have been obvious for someone with ordinary skill in the art at the time of the invention to combine forwarding mail with offering forwarding service to addressee

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if needed for the purpose to decrease unnecessary transporting of mail piece (Allen: column 2, line 11-21; Kuebert: 0009-0010).

As per claim 3, Allen discloses the method according to claim 2, but does not explicitly disclose further comprising the step of not forwarding said post to an addressee destination address if said addressee does not maintain a forwarding service. Kuebert teaches not forwarding item to addressee destination address if item is undeliverable (Kuebert, 0055, undeliverable notification may be sent to the sender. The sender can instruct the shipper to return mail item).

Therefore, it would have been obvious for someone with ordinary skill in the art at the time of the invention to combine forwarding mail with not forwarding item to addressee destination address if item is undeliverable for the purpose to decrease unnecessary transporting of mail piece (Allen: column 2, line 11-21; Kuebert: 0009-0010).

As per claim 4, Allen discloses the method according to claim 3, but does not explicitly disclose wherein said step of not forwarding further comprises the step of destroying said post. Kuebert teaches destroying item if undeliverable (Kuebert, 0055, undeliverable notification may be sent to the sender. The sender can instruct the shipper to destroy mail item).

Therefore, it would have been obvious for someone with ordinary skill in the art at the time of the invention to combine forwarding mail with destroying item if item is undeliverable for the purpose to decrease unnecessary transporting of mail piece (Allen: column 2, line 11-21; Kuebert: 0009-0010).

As per claim 5, Allen discloses the method according to claim 4, but does not explicitly disclose wherein said step of not forwarding further comprises a select time delay prior to destruction of said post. Kuebert teaches having a delay prior to destruction of item (Kuebert, 0055, undeliverable notification may be sent to the sender. The sender can then instruct the shipper to destroy mail item).

Therefore, it would have been obvious for someone with ordinary skill in the art at the time of the invention to combine forwarding mail with having a delay prior to destruction of item for the purpose to decrease unnecessary transporting of mail piece (Allen: column 2, line 11-21; Kuebert: 0009-0010).

As per claim 6, Allen further discloses the method according to claim 5, wherein said step of determining, further comprises the steps of:

- ✓ scanning an address face of said post for a TAG ID (Allen, column 4, line 5-27, USPS automated mail processing equipment to determine the delivery point ZIP code for the destination), and
- ✓ consulting a database for records related to said TAG ID, said records indicating said TAG ID is expired (Allen, column 4, line 29-42, mail carrier will recognize the address is no longer valid (typically by means of a filed change of address form)).

As per claim 8, Allen discloses the apparatus according to claim 7, but does not explicitly disclose further comprising means **for** offering a forwarding service to said addressee if said

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addressee does not maintain a forwarding service. Kuebert teaches offering forwarding service to addressee if needed (Kuebert, 0039, if the recipient wishes the parcel delivers to Chicago instead, notification allows the recipient to redirect the parcel).

Therefore, it would have been obvious for someone with ordinary skill in the art at the time of the invention to combine apparatus for forwarding mail with offering forwarding service to addressee if needed for the purpose to decrease unnecessary transporting of mail piece (Allen: column 2, line 11-21; Kuebert: 0009-0010).

As per claim 9, Allen discloses the apparatus according to claim 8, but does not explicitly disclose further comprising means **for** not forwarding said post to an addressee destination address if said addressee does not maintain a forwarding service. Kuebert teaches not forwarding item to addressee destination address if item is undeliverable (Kuebert, 0055, undeliverable notification may be sent to the sender. The sender can instruct the shipper to return mail item).

Therefore, it would have been obvious for someone with ordinary skill in the art at the time of the invention to combine apparatus for forwarding mail with not forwarding item to addressee destination address if item is undeliverable for the purpose to decrease unnecessary transporting of mail piece (Allen: column 2, line 11-21; Kuebert: 0009-0010).

As per claim 10, Allen discloses the apparatus according to claim 9, but does not explicitly disclose wherein said means **for** not forwarding further comprises means for destroying said post. Kuebert teaches destroying item if undeliverable (Kuebert, 0055,

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undeliverable notification may be sent to the sender. The sender can instruct the shipper to destroy mail item).

Therefore, it would have been obvious for someone with ordinary skill in the art at the time of the invention to combine apparatus for forwarding mail with destroying item if item is undeliverable for the purpose to decrease unnecessary transporting of mail piece (Allen: column 2, line 11-21; Kuebert: 0009-0010).

As per claim 11, Allen discloses the apparatus according to claim 10, but does not explicitly disclose wherein said means **for** not forwarding further comprises a select time delay prior to destruction of said post. Kuebert teaches having a delay prior to destruction of item (Kuebert, 0055, undeliverable notification may be sent to the sender. The sender can then instruct the shipper to destroy mail item).

Therefore, it would have been obvious for someone with ordinary skill in the art at the time of the invention to combine apparatus for forwarding mail with having a delay prior to destruction of item for the purpose to decrease unnecessary transporting of mail piece (Allen: column 2, line 11-21; Kuebert: 0009-0010).

As per claim 12, Allen further discloses the apparatus according to claim 11, wherein said means for determining further comprises:

- ✓ means **for** scanning an address face of said post for a TAG ID (Allen, column 4, line 5-27, USPS automated mail processing equipment to determine the delivery point ZIP code for the destination), and

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- ✓ means **for** consulting a database for records related to said TAG ID, said records indicating said TAG ID is expired (Allen, column 4, line 29-42, mail carrier will recognize the address is no longer valid (typically by means of a filed change of address form)).

Please Note:

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *e.g. In re Collier*, 158 USPQ 266, 267 (CCPA 1968) (where the court interpreted the claimed phrase “a connector member for engaging shield means” and held that the shield means was not a positive element of the claim since “[t]here is no positive inclusion of ‘shield means’ in what is apparently intended to be a claim to structure consisting of a combination of elements.”

The Examiner has marked examples of intended use language in bold as a courtesy to the Applicant.

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as

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potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Chen whose telephone number is (571)270-5499. The examiner can normally be reached on Mon-Thu 6:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley Bayat can be reached on 571-272-6704. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

G.C.

/Bradley B Bayat/
Supervisory Patent Examiner, Art Unit 4115